

Appln. No. 10/537,871
Atty. Docket No. H-32814A

REMARKS

Claims 19-37 are currently pending.

Claims 22 and 30 stand rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that there is not a definition for "n". Applicants have amended claims 22 and 30 to correct the typographical error. The hyphen "n" indicates that the C_3H_7 is an unbranched propyl moiety, i.e. n-propyl. As is known by one of ordinary skill in the art, C_3H_7 stands for the substituent propyl which can be branched to form iso-propyl or straight-chained (unbranched) to form n-propyl. Applicants put the "n" here to indicate that in this aspect of the invention, the propyl represents "n-propyl" and not to indicate a number for "n". Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 29 stands rejected under 35 USC 112, second paragraph, as being indefinite. Claim 29 has been amended to correct the typographical error and to remove the term "preferably". Accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections.

Claim 37 stands rejected under 35 USC 112, second paragraph, as being indefinite. Applicants have amended claim 37 to correct the typographical error as noted by the Examiner. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 19, 23 and 24 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,515,754 (Mod et al.). In order for a reference to be anticipatory, the reference must teach each and every element of the claimed invention. Mod fails to teach each and every element of Applicants' claimed invention.

Applicants' invention is directed to a vermin-repellent composition comprising a compound of formula (I) and at least one appropriate diluent or a spreading additive. Mod does not teach, or even suggest such compositions. Mod is directed to solvent-type plasticizers for vinyl-type resins. See Col. 3, lines 36-40. Nowhere in Mod is mentioned the use as a vermin-repellent composition. Mod is not directed to vermin-repellent compositions and further does not teach diluents or spreading additives necessary for such veterinary compositions as is required in the present claims. Accordingly, Mod does not teach each and every element of Applicants' claimed invention.

Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 19, 23 and 24 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,712,926 (Petersen). The examiner notes in this rejection, as in the 102(b) rejection based on Mod that the recitation of the intended use "vermin-repellent" has not been give patentable weight to distinguish over Petersen because the intended use must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. However, the Examiner stops short of the complete analysis of the preamble.

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003).

Here, the preamble clearly breathes life into the meaning and vitality of the claim, as Applicants invention is directed to vermin-repellent composition and as such requires "at least one appropriate diluent or a spreading additive" as recited in the claims. Both Mod and Petersen fail to teach, or even suggest, such diluents and additives and further do not remotely teach a vermin-repellent composition. Accordingly, neither Mod nor Petersen meet the requirements of an anticipatory reference, namely reciting each and every element of Applicants claimed invention.

Applicants respectfully request reconsideration and withdrawal of these rejections.

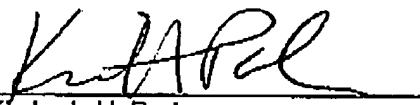
Applicants note with appreciation the allowance of claims 20, 21, 25-28 and 31-36.

Applicants believe this case is now in condition for review and Allowance. The Examiner is requested to contact the below signed attorney should any questions arise.

Applicants timely submit this paper with a petition for a three-month extension of time and payment and therefore believes that no additional fees are due. In the event that any additional fees are payable, Applicant hereby authorizes the Commissioner to charge any fees due to Deposit Account 50-4389.

Respectfully submitted,

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Denise Daniels